



[3510-16-P]

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

[Docket No. PTO-C-2014-0066]

Notice of Roundtable and Request for Comments on Domestic and International Issues Related to Privileged Communications between Patent Practitioners and their Clients

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Notice of roundtable and request for written comments.

SUMMARY: The United States Patent and Trademark Office (USPTO) is seeking input on issues regarding protections from disclosure for communications between patent applicants and their advisors. The issues include: whether and to what extent U.S. courts should recognize privilege for communications between foreign patent practitioners and their clients; the extent to which communications between U.S. patent applicants and their non-attorney U.S. patent agents should be privileged in U.S. courts; and whether and to what extent communications between U.S. patent practitioners and their clients should receive privilege in foreign jurisdictions. The USPTO is hosting a roundtable and soliciting written comments to gather information and views on these questions.

DATES: The roundtable will be held on Wednesday, February 18, 2015. The roundtable will begin at 10:00 a.m. and end at 12:30 p.m. Written comments are due by Wednesday, February 25, 2015, for full consideration.

ADDRESSES: The roundtable will be held at the United States Patent and Trademark Office, Madison Auditorium, Madison Building, 600 Dulany Street, Alexandria, Virginia 22314.

FOR FURTHER INFORMATION CONTACT: For further information regarding the roundtable or written comments, please contact Soma Saha or Edward Elliott at the Office of Policy and International Affairs, by telephone at (571) 272-9300, by e-mail at ACPrivilege@uspto.gov, or by postal mail addressed to: Mail Stop OPIA, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450, ATTN: Soma Saha or Edward Elliott. Please direct all media inquiries to the Office of the Chief Communications Officer, USPTO, at (571) 272-8400.

SUPPLEMENTARY INFORMATION:

1. Background

Innovators who seek patent protection in multiple jurisdictions may engage patent practitioners (attorneys or other registered representatives) in each of those jurisdictions. Currently, there is little consistency in whether the innovators' communications with their patent practitioners will be recognized as privileged by courts. The rules governing privilege vary from country to country and between U.S. jurisdictions. As a result, innovators may be reluctant to share critical information with their patent practitioners because the information may be subject to disclosure in judicial proceedings.

In addition, privilege issues also affect practitioners in the United States. U.S. district courts have inconsistent rules regarding the availability and scope of privilege for communications between clients and their non-attorney U.S. patent agents.

The USPTO is interested in the following topics that focus on three different aspects of privileged communications affecting U.S. entities.

First, the USPTO is interested in the state of U.S. law with respect to protecting communications between patent applicants and their non-U.S. patent practitioners from disclosure in U.S. litigation. The law in the United States differs from jurisdiction to jurisdiction. Some U.S. courts do not protect communications with foreign practitioners under any circumstances. Other courts may protect those communications, but they employ a variety of tests to decide whether and to what extent to grant privilege. Factors that U.S. courts consider include: whether the foreign practitioner acted under the direction of a U.S. attorney; whether the foreign practitioner would receive privilege under the laws of the country where the patent application was filed; and how the competing interests of all involved jurisdictions are affected. The patchwork of rules between circuits and districts can make it unclear under which circumstances communications are privileged.

Second, the USPTO is interested in how foreign courts treat communications between U.S. patent agents or attorneys and their clients. Problems arise most frequently in common law jurisdictions, some of which do not extend privilege to communications between a patent applicant and foreign patent practitioners. For this reason, Australia and

New Zealand, both common law countries, recently passed laws extending privilege to foreign patent practitioners who are authorized to provide patent advice in other countries. Civil law jurisdictions generally impose professional secrecy obligations that function similarly to privilege, but secrecy issues appear to arise less frequently in practice.

Finally, the USPTO is interested in the extent and nature of protection, if any, that U.S. courts accord to communications between clients and their non-attorney U.S. patent agents. In the United States, patent practitioners (whether agents or attorneys) must be registered to practice before the USPTO, e.g., to prosecute patent applications as an applicant's representative. In order to register, both types of practitioners must demonstrate certain legal, scientific, and technical qualifications and pass a registration exam. However, patent agents, unlike patent attorneys, are not required to be separately licensed to practice law. Communications between U.S. patent agents and their clients are treated differently by various U.S. district courts, which follow their own precedents with respect to whether the communications are privileged. Some district courts have denied privilege altogether for patent agents, while other courts have granted privilege to agents only when their work is overseen by an attorney. Still others have recognized privilege only for communications with an agent regarding activities before the USPTO, or only when the communications concern a related adversarial process.

To address the lack of uniformity for potentially privileged communications discussed above, the possibility of developing an international minimum standard for recognizing privileged communications between clients and patent practitioners has been considered

in recent years by the Standing Committee on the Law of Patents (SCP) at the World Intellectual Property Organization (WIPO). Those discussions have resulted in a compilation of relevant laws in WIPO member countries on this issue. For more information, please see WIPO document SCP/20/9, “Confidentiality of Communications between Clients and their Patent Advisors: Compilation of Laws, Practices and other Information,” available at:

http://www.wipo.int/edocs/mdocs/patent_policy/en/scp_20/scp_20_9.pdf.

This document also contains a summary of U.S. law on this issue. Separately, several industry organizations from the United States and Europe have proposed an international framework that they believe would help mitigate some of the uncertainty that exists in the current system. A copy of their proposed framework can be found at:

https://www.aippi.org/download/onlinePublications/Attachment1SubmissiontoWIPODecember182013_SCP.pdf.

The USPTO is conducting this public roundtable to solicit comments from interested parties on protecting confidential communications between innovators and their patent practitioner representatives. The number of participants in the roundtable is limited to ensure that all speakers have a meaningful opportunity to present their views. Those who wish to participate in the roundtable should submit a written request, per the instructions below. Members of the public who wish to attend and observe the roundtable need not submit a request.

Anyone may submit written comments for consideration by the USPTO on issues relevant to this notice or raised at the roundtable. The USPTO plans to make the

roundtable available via webcast. Webcast information will be available on the USPTO's Web site before the roundtable. The written comments and list of the roundtable participants and their associations will be available from the USPTO's Web site.

2. Issues for Public Comment

The topics and questions listed below reflect particular issues for which the USPTO would appreciate receiving input from interested stakeholders. Responses are not restricted to these topics; comments may provide any information the submitter wishes the USPTO to consider. The questions should not be taken as an indication that the USPTO has taken a position or is predisposed to any particular views.

1. Please explain the impact, if any, resulting from inconsistent treatment of privilege rules among U.S. federal courts. In your answer, please identify if the impact is on communications with foreign, domestic, or both types of patent practitioners.
2. Please explain how U.S. stakeholders would be impacted by a national standard for U.S. courts to recognize privilege for communications with U.S. patent agents, including potential benefits and costs. If you believe such a standard would be beneficial, please explain what the scope of a national standard should cover.
3. Please explain how U.S. stakeholders would be impacted by a national standard for U.S. courts to recognize privilege for communications with foreign patent practitioners, including potential benefits and costs. If you believe such a

standard would be beneficial, please explain what the scope of a standard should cover.

4. Please explain how U.S. stakeholders would be impacted by an international framework establishing minimum privilege standards in the courts of member countries for communications with patent practitioners in other jurisdictions, including potential benefits and costs. If you believe such a framework would be beneficial, please also address the following issues:

- a. Please identify which jurisdictions have potential problems and explain the exact nature of the problem in each of those jurisdictions.
- b. Please explain what the scope of an international framework for privilege standards should cover. An example of such a framework can be found in Appendix 5 of the following document:

https://www.aippi.org/download/onlinePublications/Attachment1SubmissiontoWIPODecember182013_SCP.pdf.

5. If a national standard for U.S. courts to recognize privilege for U.S. patent agents or foreign practitioners would be beneficial, please explain how that standard should be established.

- a. If Federal legislation would be appropriate, what should such legislation encompass? Please consider whether the Federal tax preparer-client privilege legislation, which statutorily extended attorney-client privilege to

non-lawyer practitioners (e.g., certified public accountants) under 26 U.S.C. § 7525(a), is an appropriate model and explain why or why not. Are there any noteworthy parallels or differences between Federally-registered accountants and Federally-registered patent agents in either policy or operation?

Commenters are requested to include information identifying how their organization is impacted by privilege issues, e.g., whether they are patent attorneys, agents, owners, licensees, or any other type of entity.

3. Instructions and Information on the Public Roundtable

The roundtable will be held on February 18, 2015, at the United States Patent and Trademark Office, Madison Building, 600 Dulany Street, Alexandria, Virginia 22314.

The roundtable will begin at 10:00 a.m. and end at 12:30 p.m. The final agenda and webcast information will be available a week before the roundtable on the USPTO's Office of Policy and International Affairs Web site at

<http://www.uspto.gov/ip/global/patents/index.jsp>. Pre-registration will be available from that webpage, or attendees may register at the door.

The event will be divided into two portions. The first part will feature a panel providing background on privileged communications between patent practitioners and their clients.

The second part of the event will feature presentations by various stakeholders on privileged communications and their respective positions on this issue. Both portions will explore both domestic and international issues relating to these topics. Here is a preliminary agenda:

Time	Topic
10:00 to 10:05 am	Welcome and introduction
10:05 to 11:00 am	Background panel on privileged communications
11:00 am to 12:30 pm	Presentations by interested stakeholders

SPEAKERS: Individuals interested in speaking should submit their name, contact information (telephone number and e-mail address), the organization(s) the person represents, if any, relevant biographical information, and a few brief comments on the topics to be discussed to ACPrivilege@uspto.gov by February 10, 2015. Selected speakers will be notified thereafter.

WRITTEN COMMENTS: Written comments can be submitted via the Federal Register's Web site, www.federalregister.gov, or by e-mail to ACPrivilege@uspto.gov. Comments may also be submitted by postal mail addressed to: Mail Stop OPIA, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450, ATTN: Edward Elliott. Although comments may be submitted by postal mail, electronic submissions are encouraged. The deadline for receipt of written comments for consideration by the USPTO is February 25, 2015. Written comments should be identified in the subject line of the e-mail or postal mailing as "Agent-Client Privilege." Because comments will be made available for public inspection, information that is not desired to be made public, such as an address or phone number, should not be included in the comments.

SPECIAL ACCOMODATIONS: The roundtable will be physically accessible to people with disabilities. Individuals requiring accommodation, such as sign language interpretation or other ancillary aids, should communicate their needs to Angel Jenkins at the Office of Policy and International Affairs, by telephone at (571) 272-9300, by e-mail at angel.jenkins@uspto.gov, or by postal mail addressed to: Mail Stop OPIA, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450, ATTN: Angel Jenkins, at least seven (7) business days prior to the roundtable.

Dated: January 20, 2015.

Michelle K. Lee,
Deputy Under Secretary of Commerce for Intellectual Property and
Deputy Director of the United States Patent and Trademark Office.

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